

REMARKS

Applicant has amended independent claims 1 and 8 to more precisely set forth that the indicia is made from an ink that can be seen when viewed under ultraviolet or infrared light. Thus, there is positive recitation of the capabilities of the ink that is used in informing the second indicia. This is a positive characteristic of the indicia and therefore should be considered in determining patentability of the instant application.

The Examiner, in the Official Action, has rejected claims 1, 2, 4-6 and 8 under 35 USC § 103(a) as being unpatentable over Morelle et al. in view of Ottawa Citizen for the reasons set forth therein.

MPEP 706.02(j) states:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - §2143.03 for decisions pertinent to each of these criteria.

"The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. 'To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.' *Ex parte Clapp*, 277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections."

Thus, it can be clearly seen that in order for the Examiner to present a *prima facie* case of obviousness, there must be a motivation, teaching or suggestion to combine the references, and secondly they must teach, when combined, all of the claimed limitations as taught and claimed by Applicant. In this regard, it is respectfully submitted that the two references are totally apart and distinct from each other and it would not be obvious to combine the references suggested by the Examiner. First, the Morelle reference is directed to techniques

to acquire a counterfeit proof security document, that is, to produce a document that cannot be easily duplicated (see Abstract and column 1 lines 16-26). This is accomplished by placing a particular indicia having certain physical characteristics in an area of the image. The indicia is such that when scanned the accuracy of the replication is degraded, the scanner will no longer be able to "see" of the line delineations 20 (see column 6, lines 21-34). This is in stark contrast to the Ottawa Citizen reference which is directed to postage stamps. There is no teaching or suggestion in either of the references that would lend one to being combined with the other. Applicant respectfully submits that a postal stamp is hardly a security document to which the Morelle et al. reference is directed to. In summary, Applicant respectfully submits that there is no teaching, suggestion or motivation to make the combined references suggested by the Examiner.

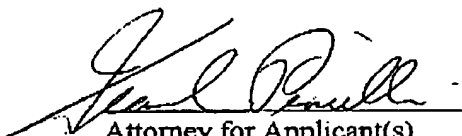
Further, even if the combination were made, there is no teaching or suggestion of all of the claimed elements of the present invention. In particular, independent claims 1 and 8 set forth the providing a first visible indicia identifying the limited edition stamps as being a limited edition, and secondly a second indicia not capable of being scanned which is not visible under normal viewing conditions for confirming that the limited stamp is a valid edition and that the indicia is made from an ink that can be seen when viewed under UV or infrared light. The claim further includes a third indicia for identifying a printer and/or location where the limited edition was printed.

The prior art totally fails to teach or suggest the indicia that is not visible under normal viewing conditions and then visible when viewed under UV or infrared light. Quite the contrary, the Morelle reference simply discloses the image that can be viewed initially, and only when it is copied is there some type of blurring such that it will be clearly seen that the copied image is not the same as the original. Thus, there is no teaching or suggestion that the second indicia is not visible under normal viewing conditions yet can be seen under UV or infrared light. Thus, for this one reason alone, the prior art fails to teach or suggest the present invention. In addition, as set forth in independent claim 1, a third indicia is used for identifying a printer and/or location where the limited edition stamp was printed. Neither of the references teach or suggest this limitation. Thus, for these additional reasons, the present invention is allowable.

In view of the foregoing Applicant respectfully submits that the prior art fails to teach or suggest the invention. Applicant has amended the independent claims to clearly set forth the positive recitation of the ink being made that can be seen under UV or infrared light. Thus, this is a positive recitation that must be considered.

In view of the foregoing, Applicant respectfully submits that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.